

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1, 3-12, 20.

The following claims are *independent*: 1, 20.

The following claims have previously been *cancelled* without prejudice or disclaimer: 2, 13-19.

Please *amend* claim 1; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices (hereinafter “amendment,” “amendments,” and/or “amended”), Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Double Patenting Rejection

Claims 1 and 3-12 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/730,224, now US Patent No. 7,529,702. Applicant submits herewith a terminal disclaimer for the instant application. Accordingly, Applicant submits that the issues raised by the Examiner with regard to the pending double patenting rejection over Application No. 10/730,224, now US Patent No. 7,529,702, have been rendered moot.

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 1, 3-12, and 20 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Maltzman, US Publication No. 2002/0107779 (hereinafter “Maltzman”), in view of Moshal, et al., US Publication No. 2001/0042041 (hereinafter “Moshal”), in further view of Sloan, et al., US Publication No. 2005/0091140 (hereinafter “Sloan”), in further view of Sheehan, et al., US Publication No. 2001/0049647 (hereinafter “Sheehan”), in further view of Buist, et al., US Publication No. 2002/0035534 (hereinafter “Buist”), in further view of Ausubel, et al., US Publication No. 2004/0054551 (hereinafter “Ausubel”), in further view of Agarwal, et al., US Publication No. 2002/0099646 (hereinafter “Agarwal”), in further view of Hoffman, et al., US Publication No. 2002/0049664 (hereinafter “Hoffman”), in further view of Eckert, et al., US Publication No. 2002/0069161 (hereinafter “Eckert”), and in further view of Official Notice.

Sloan Does Not Qualify as Prior Art

Applicant respectfully traverses the rejections and submits that a *prima facie* showing of obviousness has not been made and that Sloan may not be used in a rejection under 35 U.S.C. § 103 because it does not qualify as prior art under any category of 35 U.S.C. § 102. For example, Sloan's 35 U.S.C. § 102(e) date is Sloan's U.S. filing date of October 24, 2003. However, the instant application claims priority to U.S. Provisional Patent Application No. 60/454,817, filed March 14, 2003. As such, Applicant submits that Sloan's 35 U.S.C. § 102(e) date of October 24, 2003, is not before the earliest priority date of the instant application. Similarly, Applicant submits that Sloan's publication date of April 28, 2005, is not before the instant application's earliest priority date. Accordingly, Applicant submits that a showing of obviousness has not been established and respectfully requests reconsideration and withdrawal of this basis of rejections and allowance of claims. Should the Examiner maintain the rejection, Applicant respectfully requests further clarification as to under which category of 35 U.S.C. § 102 the Examiner believes Sloan qualifies as prior art with respect to the instant application.

Requirements to Establish Prima Facie Obviousness

The Supreme Court in *Graham v. John Deere Co. of Kansas City* prescribed that a *prima facie* showing of obviousness under 35 U.S.C. § 103 requires that, "the obviousness or nonobviousness of the subject matter [be] determined," and details further requirements, commonly referred to as "Graham factors," which include that "[1] the scope and content of the prior art [be] determined, [2] differences between the prior art and the claims at issue [be] ascertained, and [3] the level of ordinary skill in the pertinent art [be] resolved." *Graham*, 383 U.S. at 1, 17 (1966). To comply with the Graham factors, as introduced in

Graham and reaffirmed in *KSR Intern. Co. v. Teleflex Inc.*¹, MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);
- (C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

The MPEP prescribes that, “when evaluating the scope of a claim, *every limitation in the claim must be considered*,” (§ 2106 II(C), emphasis added) and, “*All words in a claim must be considered in judging the patentability of that claim against the prior art.*” (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider “every limitation in the claim” and “[a]ll words in [the] claim” in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or over-generalizing the applied reference(s). As with this Office Action, when the Examiner mischaracterizes and/or provides references that are missing claimed elements, then the Examiner has failed to fulfill MPEP § 706.02(j) requirements (A) and/or (B), and as a consequence, has failed to establish a *prima facie* case of obviousness. 35 U.S.C. § 103.

¹ The “[Graham] factors continue to define the inquiry.” 550 U.S. 398 (2007).

Missing Claim Element(s)

Applicant submits the cited references (taken alone or in combination) do **not** discuss, do **not** render obvious, and are in fact missing at least the following element(s) as recited, *inter alia*, in previously presented independent claim 20:

A computer implemented method for allocating shares of stock comprising an initial public offering, the method comprising:

...
publishing via the computer system, information descriptive of the accepted offer for the pre-auction shares, including the received pre-auction price and identification of the pre-auction bidder who bought the pre-auction shares at the received pre-auction price;

...

The Office Action asserts the above claimed elements are shown in Maltzman and alleges:

Maltzman discloses: ... publishing in the computer system, information descriptive of one or more pre-auction sales including the pre-auction price (paragraph 0029, fig. 1, server 20 and fig. 4 block 660); (Office Action, pp. 8-9).

Applicant disagrees and submits the Office Action mischaracterized Maltzman.

Instead of the Office Action's assertions, Applicant submits that Maltzman discusses *providing information regarding pending auctions prior to receiving any purchase offers* instead of the claimed "... information descriptive of the accepted offer for the pre-auction shares..." In Maltzman:

Upon receipt of the category preference or search criteria, the auction facility uses a search server 20 (see FIG. 1) to generate an item index page of relevant offerings including visual indicators displayed in respect to items in which the seller is allowing a buyer to buy [sic] the item at a pre-auction seller determined price (block 660); (Maltzman, paragraph [0029]).

Maltzman explains that "after receiving the item index page (block 670), the buyer generates a request for an item to purchase or bid on," (emphasis added) (Maltzman, paragraph [0029]). Accordingly, Applicant submits that Maltzman's *providing information regarding pending auctions prior to receiving any purchase offers* is different from at least the claimed "publishing via the computer system, information descriptive of the accepted offer for the pre-auction shares ...," as recited in independent claim 20.

Similarly, Applicant submits that the other references, taken alone or in combination, fail to remedy the deficiencies identified above in Maltzman with regard to independent claim 20. For at least the reasons discussed above, Applicant submits that the pending rejection has mischaracterized the language of the claim element(s) and/or the applied reference(s) and, thus, has not established a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of claim 20.

Although of different scope than independent claim 20, Applicant submits claim 1 (and as a consequence any claims depending therefrom) are all patentable over the cited references (taken alone or in combination) for at least similar reasons as discussed above when identifying deficiencies in the Office Action's application of Maltzman with regard to independent claim 20. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections and allowance of claims.

CONCLUSION

Applicant asserts that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to

be sufficient to overcome the prior art to this Office Action (and/or any previous office action(s)) (hereinafter "Office Action(s)"). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to the Office Action(s)' objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection(s) and/or rejection(s) as to any other claim element(s), any such re-assertion(s) of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion(s) of remarks. Consequently, the reference(s) cited the Office Action(s) do not result in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any assertions, (mis)characterizations (e.g., of claims, references, and/or otherwise), and/or Official Notice(s) in the Office Action(s). As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1, 3-12, 20, all: overcome all rejections and/or

objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209-354. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209-354.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
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